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PPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/890,261	61 08/07/2001		Thierry Livache	211842US2PCT	9176
22850	7590	08/30/2004		EXAMINER	
	-	MCCLELLAND, I	FORMAN, BETTY J		
1940 DUKE STREET ALEXANDRIA, VA 22314				ART UNIT	PAPER NUMBER
	,			1634	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)			
		09/890,261	LIVACHE ET AL.			
	Office Action Summary	Examiner	Art Unit			
		BJ Forman	1634			
Period fo	The MAILING DATE of this communication app	pears on the cover sheet w	vith the correspondence address			
A SH THE - Exte after - If the - Failu Any earn	ORTENED STATUTORY PERIOD FOR REPL' MAILING DATE OF THIS COMMUNICATION. Insions of time may be available under the provisions of 37 CFR 1.1 SIX (6) MONTHS from the mailing date of this communication. The period for reply specified above is less than thirty (30) days, a reply operiod for reply is specified above, the maximum statutory period variet to reply within the set or extended period for reply will, by statute reply received by the Office later than three months after the mailing end patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a y within the statutory minimum of th will apply and will expire SIX (6) MC, cause the application to become A	reply be timely filed irreply be timely.  NTHS from the mailing date of this communications (BANDONED (35 U.S.C. § 133).	on.		
Status						
	Responsive to communication(s) filed on 23 Ju					
2a)∐	This action is <b>FINAL</b> . 2b) ☑ This action is non-final.  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
3)∐				S "		
	closed in accordance with the practice under E	ex parte Quayle, 1955 C.	J. 11, 453 O.G. 213.			
Disposit	ion of Claims					
5) <u> </u>	Claim(s) 1-4 8-9 11-15 20-31 is/are pending in 4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed. Claim(s) is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or	wn from consideration.		*		
Applicat	ion Papers					
	The specification is objected to by the Examine					
10)	The drawing(s) filed on is/are: a) acce		•			
	Applicant may not request that any objection to the		• •			
11)	Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex			J).		
Priority ι	ınder 35 U.S.C. § 119					
a)	Acknowledgment is made of a claim for foreign All b) Some * c) None of:  1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureausee the attached detailed Office action for a list of	s have been received. s have been received in A rity documents have beer u (PCT Rule 17.2(a)).	Application No  n received in this National Stage			
Attachmen	t(s)					
	e of References Cited (PTO-892)		Summary (PTO-413)			
3) 🔲 Inforr	e of Draftsperson's Patent Drawing Review (PTO-948) nation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) r No(s)/Mail Date	5) 🔲 Notice of	s)/Mail Date nformal Patent Application (PTO-152) FECTO Comply with NA. Signs	e Rules		

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#### **DETAILED ACTION**

#### Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 May 2004 has been entered.

#### Status of the Claims

2. This action is an RCE filed 10 May in which claims 1-4, 8-9 and 11-13 were amended, claims 5-7, 10 and 16-19 were canceled and claims 20-31 were added and further in response to Supplemental Amendment filed 23 June 2004 in which claims 1 and 20 were amended. All of the amendments have been thoroughly reviewed and entered.

The previous rejections in the Office Action dated 9 January 2004are withdrawn in view of the amendments. Applicant's arguments have been thoroughly reviewed and are discussed below as they apply to the instant grounds for rejection. New grounds for rejection are discussed.

Claims 1-4, 8-9, 11-15 and 20-31 are under prosecution.

#### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 8-9, 11-15, 20-23 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teoule et al. (U.S. Patent No. 5,837,859, filed 22 September 1995) in view of Ohkawa (U.S. Patent No. 5,486,337, issued 23 January 1996).

Regarding Claim 1, Teoule et al disclose a method for producing a matrix of ligands comprising positioning an electrode relative to a conductive carrier, dispensing with the electrode a ligand coupled to an eletropolymerisable monomer (i.e. pyrrole) onto the conductive carrier and electrochemically fixing (i.e. adhered, Column 5, lines 45-56). Teoule et al do not teach depositing a discrete volume, repositioning of the electrode and repetition of the steps to for the matrix.

However, Ohkawa teach a similar method of matrix formation wherein contact between the electrode and carrier deposits a discrete volume of solution on the carrier whereby repeated steps produces a matrix of discrete deposits (Column 7, lines 7-35 and Fig. 2-4) wherein their solution deposit reduces the amount of costly solution required for dispensing the solution onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Teoule et al with the dispensing via a drop on the electrode for the expected benefit of reducing the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 2, Ohkawa et al teach the electrode comprises a reservoir and conductive part (Fig. 4).

Regarding Claim 3, Ohkawa et al teach the reservoir comprises a means for filling and evacuating the solution i.e. the opening at the top of the pipette provides means for filling and

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the opening at the bottom of the pipette provides means for evacuating (Column 7, lines 8-52 and Fig. 4).

Regarding Claim 8, Teoule et al disclose the method wherein the conductive zones are arranged on an insulating carrier (e.g. Column 14, lines 33-39).

Regarding Claim 9, Teoule et al disclose the method wherein the electrodes are interconnected (Column 5, lines 1-34) and Ohkawa teach interconnected electrodes (Fig. 1).

Regarding Claim 11, Teoule et al disclose the method wherein the conductive material is gold or platinum (Column 5, lines 10-12).

Regarding Claim 12, Teoule et al disclose the method wherein the solution comprises a doping agent (Column 9, lines 58-61).

Regarding Claim 13, Teoule et al disclose the method wherein the electropolymerizable monomer comprises pyrrole (Column 9, lines 57-61).

Regarding Claim 14, Teoule et al disclose the method wherein fixing of the ligand by electro-copolymerization of both the electropolymerizable monomer and the ligand coupled thereto (Column 5, lines 45-56).

Regarding Claim 15, Teoule et al disclose the method wherein the ligand is a nucleotide or oligonucleotide (Column 2, lines 64-67).

Regarding Claim 20, Teoule et al disclose a method for producing a matrix of ligands comprising positioning an electrode relative to a conductive carrier, dispensing with the electrode a ligand coupled to an eletropolymerisable monomer (i.e. pyrrole) onto the conductive carrier and electrochemically fixing (i.e. adhered, Column 5, lines 45-56). Teoule et al do not teach depositing a discrete volume, repositioning of the electrode and repetition of the steps to for the matrix.

However, Ohkawa teach a similar method of matrix formation wherein contact between a plurality of electrodes and carrier deposits a discrete volumes of solution on the carrier whereby repeated steps produces a matrix of discrete deposits (Column 7, lines 7-35 and Fig.

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2-4 and Claim 5-7) wherein their solution deposit reduces the amount of costly solution required for dispensing the solution onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Teoule et al with the dispensing via a drop on the electrode for the expected benefit of reducing the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 21, Ohkawa et al teach the plurality of electrodes are arranged together (Claim 5).

Regarding Claim 22, Ohkawa et al teach the electrode comprises a reservoir and conductive part (Fig. 4).

Regarding Claim 23, Ohkawa et al teach the reservoir comprises a means for filling and evacuating the solution i.e. the opening at the top of the pipette provides means for filling and the opening at the bottom of the pipette provides means for evacuating (Column 7, lines 8-52 and Fig. 4).

Regarding Claim 25, Teoule et al disclose the method wherein the conductive zones are arranged on an insulating carrier (e.g. Column 14, lines 33-39).

Regarding Claim 26, Teoule et al disclose the method wherein the electrodes are interconnected (Column 5, lines 1-34) and Ohkawa teach interconnected electrodes (Fig. 1).

Regarding Claim 27, Teoule et al disclose the method wherein the conductive material is gold or platinum (Column 5, lines 10-12).

Regarding Claim 28, Teoule et al disclose the method wherein the solution comprises a doping agent (Column 9, lines 58-61).

Regarding Claim 29, Teoule et al disclose the method wherein the electropolymerizable monomer comprises pyrrole (Column 9, lines 57-61).

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Regarding Claim 30, Teoule et al disclose the method wherein fixing of the ligand by electro-copolymerization of both the electropolymerizable monomer and the ligand coupled thereto (Column 5, lines 45-56).

Regarding Claim 31, Teoule et al disclose the method wherein the ligand is a nucleotide or oligonucleotide (Column 2, lines 64-67).

5. Claims 1-4, 8-9, 11-15 and 20-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Livache et al. (Nucleic Acids Research, 1994, 22(15): 2915-2921) in view of Ohkawa (U.S. Patent No. 5,486,337 issued 23 January 1996).

Regarding Claim 1, Livache et al disclose a method for producing a matrix comprising dispensing with an electrode a ligand on to a conductive carrier and electrochemically fixing (Abstract) by the electrode the ligand to the conductive carrier wherein the ligand is coupled to an electropolymerizable monomer (i.e. pyrrole) and wherein the dispensing and fixing are conducted simultaneously (page 2915, right column and page 2920, right column) but do not teach depositing a discrete volume, repositioning of the electrode and repetition of the steps to for the matrix.

However, Ohkawa teach a similar method of matrix formation wherein contact between the electrode and carrier deposits a discrete volume of solution on the carrier whereby repeated steps produces a matrix of discrete deposits (Column 7, lines 7-35 and Fig. 2-4) wherein their solution deposit reduces the amount of costly solution required for dispensing the solution onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Teoule et al with the dispensing via a drop on the electrode for the expected benefit of reducing

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the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 2, Ohkawa et al teach the electrode comprises a reservoir and conductive part (Fig. 4).

Regarding Claim 3, Ohkawa et al teach the reservoir comprises a means for filling and evacuating the solution i.e. the opening at the top of the pipette provides means for filling and the opening at the bottom of the pipette provides means for evacuating (Column 7, lines 8-52 and Fig. 4).

Regarding Claim 4, Livache et al teach the method wherein the dispensing electrode is a wire (page 2920, right column) but they do not specifically teach a contact between the electrode and carrier is by a drop of ligand on the electrode. However, Ohkawa teach a similar method wherein contact between the electrode and carrier is by a drop of ligand on the electrode (Column 7, lines 7-35 and Fig. 4-6) wherein the contact via the drop reduces the amount of costly ligand solution required for dispensing a ligand onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Livache et al with the dispensing via a drop on the electrode for the expected benefit of reducing the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 8, Livache et al disclose the method wherein the conductive zones are arranged on an insulating carrier (page 2917).

Regarding Claim 9, Livache et al disclose the method wherein the electrodes are interconnected (page 2917) and Ohkawa teach interconnected electrodes (Fig. 1).

Regarding Claim 11, Livache et al disclose the method wherein the conductive material is gold or platinum (Column 5, lines 10-12).

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Regarding Claim 12, Livache et al disclose the method wherein the solution comprises a doping agent (page 2917).

Regarding Claim 13, Livache et al disclose the method wherein the electropolymerizable monomer comprises pyrrole (page 2917, left column first full paragraph).

Regarding Claim 14, Livache et al disclose the method wherein fixing of the ligand by electro-copolymerization of both the electropolymerizable monomer and the ligand coupled thereto (Abstract and page 2918, left and right columns and Fig. 4).

Regarding Claim 15, Livache et al disclose the method wherein the ligand is a nucleotide or oligonucleotide (Abstract page 2918, left and right columns and Fig. 4).

Regarding Claim 20, Livache et al disclose a method for producing a matrix of ligands comprising positioning an electrode relative to a conductive carrier, dispensing with the electrode a ligand coupled to an eletropolymerisable monomer (i.e. pyrrole) onto the conductive carrier and electrochemically fixing (i.e. adhered, Column 5, lines 45-56) but do not teach depositing a discrete volume, repositioning of the electrode and repetition of the steps to for the matrix.

However, Ohkawa teach a similar method of matrix formation wherein contact between a plurality of electrodes and carrier deposits a discrete volumes of solution on the carrier whereby repeated steps produces a matrix of discrete deposits (Column 7, lines 7-35 and Fig. 2-4 and Claim 5-7) wherein their solution deposit reduces the amount of costly solution required for dispensing the solution onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Teoule et al with the dispensing via a drop on the electrode for the expected benefit of reducing the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 21, Ohkawa et al teach the plurality of electrodes are arranged together (Claim 5).

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Regarding Claim 22, Ohkawa et al teach the electrode comprises a reservoir and conductive part (Fig. 4).

Regarding Claim 23, Ohkawa et al teach the reservoir comprises a means for filling and evacuating the solution i.e. the opening at the top of the pipette provides means for filling and the opening at the bottom of the pipette provides means for evacuating (Column 7, lines 8-52 and Fig. 4).

Regarding Claim 24, Livache et al teach the method wherein the dispensing electrode is a wire (page 2920, right column) but they do not specifically teach a contact between the electrode and carrier is by a drop of ligand on the electrode. However, Ohkawa teach a similar method wherein contact between the electrode and carrier is by a drop of ligand on the electrode (Column 7, lines 7-35 and Fig. 4-6) wherein the contact via the drop reduces the amount of costly ligand solution required for dispensing a ligand onto a carrier (Column 1, line 57-Column 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the dispensing of Livache et al with the dispensing via a drop on the electrode for the expected benefit of reducing the amount of costly ligand solution required for dispensing a ligand onto a carrier as taught by Ohkawa (Column 1, line 57-Column 2, line 1).

Regarding Claim 25, Livache et al disclose the method wherein the conductive zones are arranged on an insulating carrier (page 2917).

Regarding Claim 26, Livache et al disclose the method wherein the electrodes are interconnected (page 2917) and Ohkawa teach interconnected electrodes (Fig. 1).

Regarding Claim 27, Livache et al disclose the method wherein the conductive material is gold or platinum (page 2917).

Regarding Claim 28, Livache et al disclose the method wherein the solution comprises a doping agent (page 2917).

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Regarding Claim 29, Livache et al disclose the method wherein the electropolymerizable monomer comprises pyrrole (page 2917, left column first full paragraph).

Regarding Claim 30, Livache et al disclose the method wherein fixing of the ligand by electro-copolymerization of both the electropolymerizable monomer and the ligand coupled thereto (Abstract and page 2918, left and right columns and Fig. 4).

Regarding Claim 31, Livache et al disclose the method wherein the ligand is a nucleotide or oligonucleotide (Abstract page 2918, left and right columns and Fig. 4).

## Response to Arguments

6. Applicant asserts that Teoule and Livache do not teach lateral movement of the electrode relative to the carrier, positioning the electrode above the carrier, distributing a discrete volume or repositioning as newly claimed. The argument has been considered. However, Ohkawa teaches the elements not taught by Teoule and Livache. Furthermore, as stated above, Ohkawa provides motivation for adding those elements to the methods of Teoule and Livache i.e. reduces the amount of costly solution required for dispensing onto the carrier (Column 1, line 57-Column 2, line 1) thereby reducing the cost of matrix production. It is noted that the claims do not require lateral movement of the electrode as asserted. In contrast, the claims merely require the electrode and carrier be laterally movable.

Applicant further argues that Ohkawa does not cure the deficiencies of Teoule and Livache because the electrostatic pipette of Ohkawa would lead to polymerization of the polymer inside the pipette and not on the surface of the carrier as claimed. The argument has been considered but is not sufficient to overcome the instant invention because the argument is not supported by factual evidence.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney

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statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. (see (MPEP 716.01(c).

### NOTICE TO COMPLY WITH NUCLEIC ACID SEQUENCE RULES

7. This application contains sequence disclosures (on page 17) that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN A PERIOF OF TIME **THAT IS CO-EXTENSIVE WITH** THE TIME TO REPLY TO THE ABOVE OFFICE ACTION WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.R.F. §§ 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

#### Conclusion

- 8. No claim is allowed.
- 9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

BJ Forman, Ph.D. Primary Examiner Art Unit: 1634

August 25, 2004

Application No.:9/890, Zul

# NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
7. Other:
Applicant Must Provide:
Ar initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).
For questions regarding compliance to these requirements, please contact:
For Rules Interpretation, call (703) 308-4216 For CRF Submission Help, call (703) 308-4212 PatentIn Software Program Support Technical Assistance
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